

### **REMARKS**

In this Reply, Applicants have amended claims 1 and 28. No new matter has been added. Claims 1-15, 28, and 29 are currently under examination.

In the final Office Action<sup>1</sup> ("OA"), the Examiner rejected claims 1-5 and 28 under 35 U.S.C. § 112, second paragraph as being indefinite; rejected claims 1-4, 6-9, and 11-14, 28, and 29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,966,700 to Gould et al. ("Gould") in view of U.S. Patent No. 7,099,843 to Cassidy et al. ("Cassidy"); and rejected claims 5, 10, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Gould in view of Cassidy and further in view of an article by Seiberg entitled "Risk-Indexed Capital Rules Proposed by Global Panel," American Banker, Volume 164, Issue 106, page 1 ("Seiberg").

#### **I. Withdrawal of Rejections under 35 U.S.C. § 101**

Applicants thank the Examiner for withdrawing the 35 U.S.C. § 101 rejections that were in the previous office action.

#### **II. Rejections under 35 U.S.C. § 112, second paragraph**

The final Office Action contends that claims 1-5 and 28 are unclear because they recite "a computer system." OA at pg. 2. Applicants disagree because the specification discloses a computer system in several places, including by disclosing a data processing system in Fig. 1. Applicants are not required to use the exact same words in the claims as are used in the specification. "[T]here is no *in haec verba* requirement,

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<sup>1</sup> To the extent that the Examiner characterized the claims or the teachings of the prior art in the office action, Applicants decline to agree with any such characterizations.

newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure.” M.P.E.P. § 2163.

Nonetheless, purely to advance prosecution and place this application in condition for allowance, Applicants have amended claims 1 and 28 in accordance with the Examiner’s suggestion in the Office Action, rendering moot this rejection. Accordingly, Applicants request that the Examiner withdraw the rejection of claims 1-5 and 28 under 35 U.S.C. § 112, second paragraph.

III. Rejections under 35 U.S.C. § 103(a) in view of Gould, Cassidy, and Seiberg

A. The Cassidy reference is not prior art

Applicants traverse the 35 U.S.C. § 103(a) rejections of claims 1-15, 28, and 29 because the Cassidy reference is not prior art to the present application according to 35 U.S.C. § 103(c)(1), and therefore the final Office Action cannot properly rely on Cassidy to establish a *prima facie* case of obviousness.

The Cassidy patent issued on August 29, 2006, and was not published before it issued. Cassidy’s issue date of August 29, 2006 is later than the March 31, 2004, filing date of the present application. Because Cassidy was filed on March 14, 2002, but did not issue (or publish) until after the present application’s filing date, Cassidy appears to qualify as prior art, if at all, only under 35 U.S.C. § 102(e).

The subject matter of Cassidy and the subject matter of the present invention, however, were both subject to assignments to The Federal Home Loan Mortgage Corporation (aka Freddie Mac), at the time the present invention was made. This is evidenced by the Assignments recorded in the U.S. Patent and Trademark Office at Reel 015673, Frame 0590 and at Reel 012939, Frame 0768. Under 35 U.S.C.

§ 103(c)(1), “[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.” Therefore, because Cassidy was assigned to the same entity as the present application, namely Freddie Mac, and because Cassidy qualifies as prior art only under 35 U.S.C. § 102(e), Cassidy cannot be used to preclude patentability under § 103.

The final Office Action relies on the Cassidy reference to form the combinations used to reject all of the pending claims 1-15, 28, and 29. This is improper because the Cassidy reference cannot be used as prior art to preclude patentability of the present application according to 35 U.S.C. § 103(c)(1). Without Cassidy, the final Office Action fails to establish a *prima facie* case of obviousness for claims 1-15, 28, and 29. Accordingly, the 35 U.S.C. § 103(a) rejections of claims 1-15, 28, and 29 must be withdrawn.

As a related note, Applicants point out that the impropriety of the 35 U.S.C. § 103(a) rejections in the final Office Action is unrelated to Applicants’ claim amendments, which merely change the form of claims 1 and 28 to address the 35 U.S.C. § 112, second paragraph rejection, without changing the substance of these claims. Accordingly, it would be improper to issue another final Office Action, should the Examiner attempt to apply new prior art to the claims, as the minor formal amendments to claims 1 and 28 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner.

B. The final Office Action misinterprets the scope and content of the prior art and fails to provide a reason to combine the prior art references

Applicants also maintain their previous traversal of the § 103(a) rejections. In the final Office Action, the Examiner rejected claims 1-4, 6-9, 11-14, 28 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Gould in view of Cassidy and rejected claims 5, 10, and 15 under 35 U.S.C. § 103(a) over Gould in view of Cassidy and Seiberg. As explained in detail in the Reply filed May 12, 2009, (hereby incorporated by reference), Applicants traverse because the final Office Action misinterprets the scope and content of the Gould reference, does not properly ascertain the differences between the cited references and the claims, and provides no reasons as to why the combination of references and the claimed inventions would have been obvious. In particular, contrary to the final Office Action's contentions, Gould fails to teach or suggest a method or system for reducing capital required to be held in connection with a subject pool of loans that includes "applying . . . capital reserve requirements to the subject pool based on the credit risk rating and the credit risk allocated to a party subject to the capital reserve requirements for loans in the subject pool; [and] calculating, . . . an amount of capital to hold against the subject pool based on application of the capital reserve requirements," among other things. In addition, the final Office Action fails to provide any reasons as to why it would have been obvious for one of ordinary skill to have combined the cited references. For these additional reasons, the final Office Action fails to establish a *prima facie* case of obviousness for rejecting claims 1-4, 6-9, and 11-14, 28, and 29 under 35 U.S.C. § 103(a).

#### IV. Conclusion

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-15, 28, and 29 in condition for allowance.

Applicants submit that the proposed amendments of claims 1 and 28 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were earlier claimed and inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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